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EXAMINER

POLLACK, MELVIN H

ART UNIT

PAPER NUMBER

2145

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/551,014

Applicant(s)

ROMA, NORBERT

Examiner

Melvin H Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/17/04 have been fully considered but they are not persuasive. A response to the applicant's various arguments are provided below.
2. The original objection to the drawings has been withdrawn in light of the new drawings. However, the new drawings necessitate a new objection due to minor informalities.
3. The examiner withdraws the 112 rejection, due to the arguments provided by the applicant.
4. The applicant alleges that Schultz does not expressly disclose three separate items that may be labeled a "data stream", "resource," and "selected items." The applicant fails to specify which two parts he believes Schultz teaches, and which part he believes to be missing. As the examiner interprets the art, Schultz teaches a document record archive (data stream) and a plurality of metadata fields (resource) that is related but separate from the document record archive. Schultz further teaches that a document theme (topic) is analyzed against both items to provide scores (results), which are then used to select documents from the said document records to form a results list (selected items list). Therefore, Schultz teaches all three items, and the rejection stands.
5. The applicant alleges that Eichstaedt does not expressly disclose that the same "said profile" throughout the analysis. The examiner states his interpretation that, as shown in the past office action, Eichstaedt clearly teaches that the same profile is used. The examiner does challenge the user on the broadness of the claims (P. 4, line 18 – P. 5, line 3), but the purpose is to show that the term "said profile" does not expressly exclude updating of the profile during the

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method nor expressly exclude profile updating between method iterations. As for the precise phrase cited, the examiner meant that the claims as currently drawn would allow a user to use profile 1 during a first iteration and profile 2 during a second iteration, as opposed to a user using profile 1 during the analyzing step and profile 2 during the scoring step. At any rate, the examiner does not rely upon the breadth of the term, and Eichstaedt clearly does not change profiles during the method. Therefore, the rejection stands.

6. As for claims 3-8, the applicant states that the claims are patentable "not only by virtue of its dependency from a base claim that is patentable, but also for the totality of features recited in it." Applicant does not state, however, which features the dependent claims add to the totality of the features that he believes to be patentable. Applicant's arguments in regards to claims 3-8 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

7. For the reasons above, the previous art rejections stand. This rejection is made final.

Drawings

8. The drawings were received on 9/17/04. These drawings are not acceptable due to drawing informalities.

9. The drawings are objected to because of drawing informalities such as line type, lettering style, and the left margin of Fig. 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number

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of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

10. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as “Annotated Marked-up Drawings” and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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12. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Schultz (6,208,988).

13. For claim 1, Schultz teaches a method (see abstract) of selecting documents from a data stream (col. 1, lines 5-20), comprising:

- a. Selecting a resource having information comparable to said data stream (col. 1, lines 45-55);
- b. Selecting at least one topic (Fig. 2, #206, 208; “theme”);
- c. Analyzing said topic against said resource (col. 1, lines 50-55; “metadata”);
- d. Analyzing said topic against said data stream (col. 1, lines 50-67; “document records”); and
- e. Comparing results from said data stream analysis to results from said resource analysis to select a document from said data stream (Fig. 2, #208, 210; “results list”).

14. Claims 2, 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Eichstaedt et al. (6,385,619).

15. For claim 2, Eichstaedt teaches a method (see abstract) of selecting documents (col. 1, lines 5-11) from a data stream (Fig. 2, #58 and #64), comprising:

- a. Selecting a profile (Fig. 2, #62);
- b. Analyzing a reference corpus of documents against said profile to determine at least one score (col. 1, lines 35-55);
- c. Scoring at least one document from said data stream against said profile (col. 3, lines 15-25); and

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d. Comparing said scores from said data stream document to said at least one score from said reference corpus to select said document from said data stream (col. 1, lines 59-62).

16. As for claim 3, Eichstaedt teaches that the method further comprises determining a plurality of reference corpus scores defining a plurality of delivery ratios, and determining a delivery ratio that corresponds to said score from said data stream document to select said data stream document (col. 4, lines 4-30).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eichstaedt as applied to claims 2, 3 above, and further in view of Cook et al. (5,557,227).

19. For claim 4, Eichstaedt does not expressly disclose that the scores are determined according to an exponential decay function, further defined in claim 5. Eichstaedt does disclose that a decay function of a generic type is used (col. 4, lines 6-8), and that many suitable scoring functions may be used with similar effect (col. 4, lines 15-16). Cook teaches the definition and use (see abstract) of an exponential decay function (col. 1, lines 9-11). At the time the invention was made, one of ordinary skill in the art would have used said function because it is easy to emulate in a computer (col. 1, lines 14-15). Further, the choice of function is a design choice.

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20. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eichstaedt as applied to claims 2, 3 above, and further in view of Heckerman et al. (6,529,895).

21. For claim 6, Eichstaedt does not expressly disclose that the scores are determined according to a power law function, further defined in claim 7. Eichstaedt does disclose that a decay function of a generic type is used (col. 4, lines 6-8), and that many suitable scoring functions may be used with similar effect (col. 4, lines 15-16). Heckerman teaches the definition and use (see abstract) of an exponential decay function (Fig. 6a). At the time the invention was made, one of ordinary skill in the art would have used said function because it can be used to model a variety of items in accordance with Zipf's law (col. 10, lines 53-64). Further, the choice of function is a design choice.

22. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz as applied to claim 1 above, and further in view of Evans (6,473,755).

23. Claim 8 is drawn to many of the limitations of claim 1, which Schultz teaches as shown above, but is further drawn to the steps of:

- a. Receiving an information request from a communication network (Fig. 2, #202);
- b. Selecting a data source (see below); and
- c. Transmitting said retrieved documents over said communications network (Fig. 2, #210).

24. Schultz teaches the reading of multiple data sources into a database (Fig. 1, 110 and 112), but does not expressly disclose selecting a data source. Evans teaches the selection of a data source (Fig. 2, 120). At the time the invention was made, one of ordinary skill in the art would

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have modified Schultz to use multiple databases so as to concentrate documents related by topic for faster processing (col. 5, lines 5-15).

25. As to claims 9-20, they do not teach or define above the correspondingly rejected claims 1-8 and thus claims 9-20 are rejected for the reasons given above.

Conclusion

26. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
04 January 2005



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